

REMARKS

Further and favorable reconsideration is respectfully requested in view of the foregoing amendments and the following remarks.

Claims 1, 3-5, 7, 9-16, 18, 19, 24-26 and 30 are pending in this application.

Claims 1, 4, 10 and 24 have been amended to delete “hydrogen” from the definition of R². Claim 1 has also been amended to delete “provided that a compound wherein R² is hydrogen and X² is -O- are excluded” because R² can no longer be hydrogen, and to narrow the definition of X³.

Claims 3 and 4 have been amended to recite that R² can be “optionally substituted lower alkynyl”. Support for this amendment can be found on page 4, line 23 of the specification.

Applicants thank Examiner Loewe for extending her prior art search to the full scope of the claimed compounds.

I. Claim Rejection Under 35 U.S.C. § 112

The Examiner rejects claims 3 and 4 under 35 U.S.C. § 112, second paragraph, as being indefinite. Claims 3 and 4 have been amended to recite that R² can be “optionally substituted lower alkynyl” in order to be consistent with the definition of R² in claim 1. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

II. Claim Rejection Under 35 U.S.C. § 103

The Examiner rejects claims 1, 3-5, 7, 9-16, 18, 19, 24-26 and 30 under 35 U.S.C. § 103(a) as being obvious over Filzen et al. (WO 03/084916). As applied to the amended claims, Applicants respectfully traverse the rejection.

The Examiner asserts that the reference discloses the four compounds depicted on pages 3-4 of the Office Action. Applicants note that the first compound depicted is the same compound cited by the Examiner in rejecting the claims over the Filzen et al. reference in the Office Action of January 22, 2008.

However, in item 4 on page 2 of the Office Action of May 13, 2009, the Examiner indicates that the Declaration filed December 4, 2008 is sufficient to overcome the 35 U.S.C. § 103 rejection over the Filzen et al. reference. Thus, the rejection should be withdrawn for this reason alone.

Moreover, the claims have been further amended to delete “hydrogen” from the definition of R². A substituent (other than hydrogen) at the R² position demonstrates unexpectedly strong PPARδ activity, as shown in the previously filed Declaration. The Declaration shows that it is surprising and unexpected for compound β-1-3, which has a methyl group at the R² position and is within the claimed genus of compounds, to have an EC₅₀ value for PPARδ activity four times lower than the reference compound, which has a hydrogen atom at the R² position. Accordingly, it is surprising and unexpected that the claimed β-1-3 compound is four times more potent than the reference compound.

In addition, as agreed upon during the personal interview held January 30, 2009, the Declaration also shows that it is surprising and unexpected for compound β-1-15, Compound 1 and Compound 2, which have CO₂Me, CH₂OMe and CH₂OEt groups, respectively, at the R² position and are within the claimed genus, to have an EC₅₀ value for PPARδ activity of more than 25 times lower than that of the reference compound. Therefore, it is surprising and unexpected that a substituent (other than hydrogen) at variable R² of formula (I) demonstrates very strong PPARδ activity.

As a result, the presently claimed compounds would not have been obvious over the reference. Therefore, claim 1, 3-5, 7, 9-16, 18, 19, 24 and 25 would not have been obvious over the reference.

Claims 26 and 30 depend from claims 1 and 24, respectively, and thus also would not have been obvious over the reference.

Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

III. Double Patenting

The Examiner provisionally rejects claims 1, 3-5, 7, 9-16, 18, 19, 24-26 and 30 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-7 and 13-17 of copending application no. 11/920,999.

A terminal disclaimer has been filed in the copending application. Therefore, the provisional rejection should be withdrawn.

IV. Conclusion

For these reasons, Applicants take the position that the presently claimed invention is clearly patentable over the applied references.

Therefore, in view of the foregoing amendments and remarks, it is submitted that the rejections set forth by the Examiner have been overcome, and that the application is in condition for allowance. Such allowance is solicited.

Respectfully submitted,

Yoshikazu FUKUI et al.

By /Andrew B.
Freistein/

Digitally signed by /Andrew B. Freistein/
DN: cn=/Andrew B. Freistein/, o=WLP,
ou=WLP, email=afrestein@wenderoth.
.com; c=US
Date: 2010.08.20 12:04:05 -04'00'

Andrew B. Freistein
Registration No. 52,917
Attorney for Applicants

ABF/mac
Washington, D.C. 20005-1503
Telephone (202) 721-8200
Facsimile (202) 721-8250
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